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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/536,862

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Jan-Christoph Wollmann

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07/08/2010

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EXAMINER

PRICE, NATHAN R

ART UNIT

PAPER NUMBER

3763

MAIL DATE

DELIVERY MODE

07/08/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/536,862	Applicant(s) WOLLMANN ET AL.	
	Examiner NATHAN R. PRICE	Art Unit 3763	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 12-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 12-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This office action is responsive to the amendment filed on April 19, 2010. As directed by the amendment: claims 1-10, 16, 17, and 19 have been amended, claim 11 has been cancelled, and no new claims have been added. Thus, claims 1-10 and 12-19 are presently pending in this application.
2. The amendments are sufficient to overcome the claim objections from the previous action, and to overcome the rejections under 35 U.S.C. 112 from the previous action.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-10, 12-14, 16, and 17-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Herman (US 4014463).
5. Regarding claims 1-10, 12-14, 16, and 17-19, Herman discloses a device for producing medicinal foam (see fig. 1), comprising an active agent chamber 12 closed with a first piston 18; a gas chamber 16 closed with a second piston 14 and closed with the first piston (see fig. 1), the gas chamber and the active agent chamber being arranged one after another (see fig. 1), and a foam producing device (mixer 48) connected with the active agent chamber and the gas chamber (see fig. 1), wherein

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both pistons may be interconnected and displaced in common (see fig. 1; displacement of 14 also displaces 18) to cause a pressure increase both in the active agent chamber and the gas chamber and to feed the active agent and the gas to the foam producing device (col. 4, ln. 15-35), and wherein the two pistons are interconnected through a connecting element in the form of a hollow needle 30 which opens one of the chambers when it is displaced; openings defined through the second piston (openings defined near 40 and 34 elements on fig. 1); the connecting element comprises a feed channel 46; an entrainment element 36 for entraining one of the two pistons, rigidly connected to the hollow needle between the first and second pistons (see fig. 1) in a position offset from the open end of the hollow needle (see fig. 1), upon displacement of the second piston to a point where the hollow needle pierces through the first piston (such as shown in fig. 1) and the entrainment element contacts the first piston (fig. 1), the entrainment element maintains a distance between the first and second pistons to allow a pressure increase in both chambers (see fig. 1 and col. 4, ln. 15-35; element 36 allows 14 and 18 to move in unison while applying pressure to both chambers); the feed channel connects the chamber opened by the connecting element immediately with the foam producing device (see fig. 1); the chambers adjoin each other (see fig. 1); the foam producing device has a foam exit opening 80 and a sieve 52; a slow-down element 26; the connecting element has openings (on either end, see fig. 1); the foam producing device is removably connected to the second piston by a holder (holder 58, mutually connected with second piston to element 10) comprising a foam exit opening (centrally located passageway of 58).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Herman in view of Chu (US 4743229).

8. Regarding claim 15, Herman discloses the apparatus as claimed except for a Luer. However, Chu teaches use of a Luer to connect a mixing device to a syringe (see fig. 1). It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a Luer fitting as taught by Chu for the purpose of permitting interaction with a wide range of devices.

Response to Arguments

9. Applicant's arguments filed April 19, 2010 have been fully considered but they are not persuasive.

10. Applicant argues that Herman lacks a "gas chamber". Examiner respectfully disagrees. It appears that Applicant is arguing that Herman's disclosure of his intended use of the apparatus does not describe using the element cited by Examiner as a gas chamber. However, Examiner maintains that element 16 of Herman is a chamber. Furthermore, the term "gas" in front of chamber is a recitation of the intended use of the chamber, to hold gas. Examiner notes that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention

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and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In the instant case, the structure 16 of Herman is a chamber and capable of being used as claimed.

11. Applicant argues that Herman fails to disclose first and second pistons displaced in common. Examiner respectfully disagrees. Applicant argues that elements 18 and 36 are not displaced in common. However, Examiner has cited element 18 as the first piston and element 14 as the second piston. Element 14 is a piston at least in that it moves within the device to expel material 16. Element 14 and element 18 are displaced in common.

12. Applicant argues that Herman fails to disclose “the first and second pistons are interconnected through a connecting element which opens one of the active agent and gas chambers when it is displaced”. Examiner respectfully disagrees. Once again, Applicant cites element 36 as the second piston. Examiner has cited element 14 as the second piston (see above). Examiner maintains that elements 18 and 14 are interconnected via element 30 at least in that elements 14 and 18 are mutually connected to element 30. Element 14 is connected to element 30 via intermediate element 36. Element 18 is connected to element 30 via interaction at element 34. That piston 18 is adapted to slide along element 30 does not preclude that it is connected to element 30. Furthermore, Examiner maintains that the opening of 26 by 30 is an opening of the active agent chamber.

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13. Applicant argues that Herman fails to disclose a gas chamber closed with the second piston and closed with the first piston. Examiner respectfully disagrees. Once again, Examiner cites element 18 as the first piston and element 14 as the second piston (see above). The chamber cited by Examiner as the gas chamber is closed on one end by 14 and on another end by 18. Therefore, it meets the claim limitation.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NATHAN R. PRICE whose telephone number is (571)270-5421. The examiner can normally be reached on Monday-Thursday, 9:00 a.m. - 5:00 p.m. EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nicholas Lucchesi can be reached on 571-272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/N. R. P./
Examiner, Art Unit 3763

/Nicholas D Lucchesi/
Supervisory Patent Examiner, Art
Unit 3763